## REMARKS

This response is intended as a full and complete response to the final Office Action mailed January 26, 2005. In the Office Action, the Examiner notes that claims 1-20 and 23-26 are pending and rejected. By this response, claims 1, 9, 10, 17, 20 and 25 have been amended and claim 26 has been cancelled. The amendments to the claims are fully supported by the Specification. For example, the amendments to claims 1, 9, 10 and 25 are supported at least by page 26, line 24, through page 27, line 6. The amendments to claims 17 and 20 are supported at least by page 29, line 10, through page 31, line 23. Thus, no new matter has been introduced and the Examiner is respectfully requested to enter the amendments to the claims.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

## Rejections under 35 U.S.C. §103

### Claims 1-21 and 23-26

The Examiner has rejected claims 1-21 and 23-26 as being unpatentable over U.S. Patent No. 5,631,693 to Wunderlich et al. (hereinafter "Wunderlich") in view of U.S. Patent No. 5,818,511 to Farry et al. (hereinafter "Farry") and further in view of U.S. Patent No. 6,357,276 to Banker (hereinafter "Banker"). The Applicants respectfully traverse the rejection.

Claims 1, 9, 10 and 25

The Applicants' claim 1 recites (emphasis added below):

> "1. An apparatus for video on demand programs comprising:
> a receiver to receive requests for video on demand programs;
> a network manager, connected to said receiver, to process said



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program requests;

an authorization component, connected to said network manager, to transmit a first authorization code, in response to a request for a video on demand program, to authorize a set top terminal to tune to a specific preview channel and to enable delivery of a requested program; and

a file server, coupled to said network manager, capable of receiving said first authorization code and sending a second authorization code, wherein when the requested program is scrambled, the second authorization code enables descrambling said scrambled requested program."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). Wunderlich, Farry and Banker alone or in combination fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Wunderlich, Farry and Banker references, alone or in combination, fail to teach or suggest at least the "authorization component, connected to said network manager, to transmit a first authorization code, in response to a request for a video on demand program, to authorize a set top terminal to tune to a specific preview channel and to enable delivery of a requested program" as recited in claim 1.

Wunderlich discloses a "system [which] comprises a headend coupled to a distribution network having a multiplicity of subscribers," the system having an "on demand services feature for the provision of video, audio, and data services" (abstract). However, as the Examiner acknowledges, Wunderlich "fails to specifically disclose an authorization component to transmit a first authorization code to enable set top terminals to receive a requested program, use of a preview channel, and a second authorization code to descramble a scrambled program as recited in the claims." (page 5, 1/26/05 Office Action)



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Farry fails to bridge the substantial gap between the Wunderlich reference and the Applicants' invention as recited in claim 1. Farry discloses a digital switching network which accommodates video on demand. In particular, Farry discloses:

> "If the service requested is a premium service, such as video-on-demand, the level 1 gateway initiates a connection via the X.25 network to the an information server 501 or to the ISP. It notifies the IS of a billing number associated with the subscriber. The server then notifies the level 1 gateway over the reverse path whether or not service is authorized to the subscriber. If service is not authorized, the level 1 gateway will provide a message to the DET and, depending on circumstances, may provide the DET user with an opportunity to subscribe to the service." (column 11, lines 25 -35)

However, Farry does not teach or suggest an authorization component to transmit a first authorization code, in response to a request for a video on demand program, to authorize a set top terminal to tune to a specific preview channel.

Furthermore, Banker also fails to bridge the substantial gap between the Wunderlich and Farry references and the Applicants' invention as recited in claim 1. The Examiner relies on Banker to teach "use of a preview channel" (page 5, 1/26/05 Office Action). However, this is not what is recited in claim 1 as amended. The Examiner further states that "Banker teaches a program event transaction including two initial bytes of event identification for the program event. In the first transaction ED1, there is a byte that indicates that the event may be previewed (col. 9, ll. 34-40), which reads on an authorization code to enable a set top terminal to tune to a specific preview channel or preview" (page 2, 1/26/05 Office Action). However, the Applicants respectfully disagree. Specifically, Banker discloses (emphasis added below):

> "A near video on demand event transaction is more fully disclosed in FIG. 4. The transaction provides a number of parameters which are downloaded from the headend 10 to each subscriber terminal for each program event in a NVOD system. The system provides the information as a global transaction transmitted to all subscriber terminals in the VBI of the video signal. The event transaction data is decoded by the VBI decoder and stored in the event portion of the DRAM until it is needed by the subscriber terminal 40. The program event transactions include two initial bytes of event identification for the program event. The total event data to describe a NVOD program event is generally six transactions (ED1-ED6) in length. In the first transaction ED1, next is a byte which indicates when the event may be previewed. Thereafter, two bytes are taken up by a number indicating the channel on which the event will be



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> displayed. Following the display channel information, are two bytes indicating the maximum number of showings of the program event. A byte indicating when the program event may be purchased follows this information. Thereafter, there are 3 bytes indicating frequency on which the on screen barker channels may be viewed to see the preview. Another byte showing the attributes of the event indicates the rating of the program event, and whether or not to mute it or to blank it, and another 3 bits for control purposes. Following this basic information the transaction indicates the starting time and the interval between each starting time." (column 9, lines 24-54)

Banker also discloses (emphasis added below):

> "The subscriber terminal provides an on screen display interface for ordering the NVOD service. The NVOD service is provided by the same general operation used for pay-per-view and impulse pay-per-view selections as shown in FIGS. 5-7. There are several methods of initiating a pay-per-view sequence for the subscriber terminal 40. Initially, if the subscriber has tuned a global preview channel in block A10 he may watch the preview and be prompted with the message to press the PPV key to purchase one of the program events he is previewing. Alternatively, he may press the PPV key from any channel which he is tuned to which takes him to block A14. As another method, if the features key is pressed, the features menu in block A12 has a selection for choosing PPV programs which takes the subscriber to the pay-per-view selection screen A14." (column 10, lines 1-16)

Thus, as can be seen from the above-recited sections of Banker, the 'transaction' to which the Examiner refers is a piece of information which is transmitted to every set top terminal. The 'transaction' does not authorize anything, it merely describes to every terminal where the preview exists. In contrast, the first authorization code of the present invention is in fact an authorization code, which authorizes the recipient of the authorization code to view a specific preview channel while the purchased program is being prepared. Furthermore, the first authorization code is transmitted in response to a request for a video on demand program. The 'transaction' of Banker is globally transmitted to all of the terminals (and is more akin to a program guide), and is not transmitted in response to a request for a video on demand program. In fact, as can be seen in the above-recited sections of Banker, the subscriber purchases the program only after viewing the preview. Thus, Banker does not teach or suggest an authorization component to transmit a first authorization code, in response to a request



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for a video on demand program, to authorize a set top terminal to tune to a specific preview channel.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 9, 10 and 25 contain substantially similar relevant limitations as those discussed above in regards to claim 1. As such, the Applicants submit that independent claims 9, 10 and 25 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-8 and 11-16 depend, either directly or indirectly, from independent claims 1, 9, 10 and 25 and recite additional limitations thereof. As such, and for at least the same reasons as discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejection of such claims under 35 U.S.C. §103(a) be withdrawn.

Claims 17 and 20

The Applicants' claim 17 recites (emphasis added below):

> "17. An apparatus for delivering video on demand programs to set top terminals comprising:
> an authorization component to receive requests for video on demand programs from the set top terminals;
> an interface connected to said authorization component;
> a network manager, connected to said interface, comprising:
> a timer, wherein the network manager monitors program requests for a same program within a time period extending from an initial request for a video on demand program; and
> a processor to process said program requests, wherein said processor includes an instruction memory, and said processor comprises control software to compile, group or count said program requests; and
> a file server, connected to said authorization component, capable of receiving a first authorization code to enable delivery of a requested program and sending a second authorization code, wherein when the requested program is scrambled, the second authorization code enables descrambling said scrambled requested program."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy,



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110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Wunderlich, Farry and Banker alone or in combination fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Wunderlich, Farry and Banker references, alone or in combination, fail to teach or suggest at least the "timer, wherein the network manager monitors program requests for a same program within a time period extending from an initial request for a video on demand program" as recited in claim 17.

Wunderlich discloses a "system [which] comprises a headend coupled to a distribution network having a multiplicity of subscribers," the system having an "on demand services feature for the provision of video, audio, and data services" (abstract). However, Wunderlich fails to teach or suggest the claimed timer which the network manage uses to monitor program requests for a same program within a time period extending from an initial request for a video on demand program.

Farry fails to bridge the substantial gap between the Wunderlich reference and the Applicants' invention as recited in claim 17. Farry discloses a digital switching network which accommodates video on demand. However, Farry also fails to teach or suggest the claimed timer which the network manage uses to monitor program requests for a same program within a time period extending from an initial request for a video on demand program.

Furthermore, Banker also fails to bridge the substantial gap between the Wunderlich and Farry references and the Applicants' invention as recited in claim 17. Banker discloses a near video on demand system having a time shifting feature. However, Banker also fails to teach or suggest the claimed timer which the network manage uses to monitor program requests for a same program within a time period extending from an initial request for a video on demand program.

As such, the Applicants submit that independent claim 17 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 20 contains substantially similar relevant limitations as those discussed above in regards to claim 17. As such, the Applicants submit that



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independent claim 20 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 18-19 and 23-24 depend, either directly or indirectly, from independent claims 17 and 20 and recite additional limitations thereof. As such, and for at least the same reasons as discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejection of such claims under 35 U.S.C. §103(a) be withdrawn.

## CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application, are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 3/25/05

E. J. Wall

Eamon J. Wall
Registration No. 39,414
Attorney for Applicant

MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808



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